

REMARKS

Reconsideration of the above-identified application in view of the present amendment is respectfully requested.

The abstract has been amended to overcome the objection on page 2 of the office action. Applicant respectfully submits that in consideration of the replacement formal drawing sheets complying with the examiner's requirements to show plastic and foam drawing symbols, the remainder of the objections to the disclosure and the drawings should be withdrawn.

Claims 1-12 remain in this application. Claims 1-11 have been amended. Claim 12 is newly presented.

The office action contained an objection under 35 USC §112, second paragraph of the term "displaceable" in claim 1 as being indefinite and vague because anything is displaceable if enough force is applied to it. See "flexible" or "flexibility" in Fredman v. Harris-Hub Co., Inc., 163 USPQ 397 (DC NILL 1969).

The Fredman court determined that the term flexible is a relative term and therefore considered the surrounding claim language as well as passages in the patent specification to explain the relative degree of flexibility. (Id. at 401).

Further, the fact that the term "displaceable" is a relative term does not automatically render the claim indefinite under §112, second paragraph. Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the

specification. When a relative term is recited in a claim, the first determination is whether the specification provides some standard for measuring that degree. In re Oetiker, 951 F.2d 1267, 23 USPQ2d 1661, 1662 (Fed. Cir. 1991) (unpublished) (citing Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 221 USPQ 568, 573-74 (Fed. Cir. 1884)). If the specification provides no guidance, determination is made as to whether one of ordinary skill in the art, in view of the prior art, would nevertheless be reasonably apprised of the scope of the invention. (Seattle Box, 221 USPQ at 574).

Concerning the term displaceable in claim 1, the surrounding claim language itself as well as the specification, explains the standard for measuring the degree which the covering cap is "displaceable". Claim 1 recites that the covering cap is mounted so as to be displaceable in an axial direction for actuation of a horn. The specification page 1 in the Background of the Invention, states that "[t]o actuate the horn, the covering cap and possibly the entire module is moved in the axial direction, i.e. in the direction of the steering column, until the horn contacts are closed." The specification and claim 1 explains that the specific degree of displacement needed in an axial direction is to contact the electrical contacts to activate the horn.

In addition, one of ordinary skill in the art, in view of the prior art, would be reasonably apprised of the scope of the invention that the covering cap is displaceable to the specific degree of displacement in an axial direction needed to contact the electrical contacts to activate the horn.

Applicant respectfully submits that the relative degree of the term displaceable is defined in claim 1 with particularity and definiteness. Thus, the term displaceable is not vague and indefinite.

The office action also stated that the term "displaceable" is vague because the cap is not required to be displaced in an axial direction. Applicant respectfully submits that claim 1 states that the covering cap is displaceable in an axial direction for actuating the horn. Thus, the cap is required to be displaced to actuate the horn. The term displaceable is not vague and this rejection should be withdrawn.

The term non-removable has been deleted from claim 8.

Claims 1-4 and 6-11 have been rejected under 35 USC §102(b) as being anticipated by Bohn et al. (EP 0945310 A2). However, reference is subsequently made to the equivalent U.S. patent no. 6,312,012.

Anticipation requires a single prior art reference that discloses each element of the claim. W.L. Gore & Associates v. Garlock, Inc., 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), cert. denied 469 U.S. 851 (1984). Additionally, the single prior art reference must disclose each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention". Scripps Clinic & Research Foundation

v. Genentech Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991).

"The identical invention must be shown in as complete detail as is contained in the ... claim". Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

It is respectfully submitted that the Examiner has not established a *prima facie* case of anticipation because each and every element of claim 1 is not disclosed by the Bohn et al. patent. Specifically, the patent to Bohn et al. does not disclose or suggest guides that, upon laterally pressing down said covering cap for actuating said horn, are tilted allowed by a yielding of the foam casing.

The Examiner proffers that the bolts 10 in the Bohn et al. patent are inherently tilted by a yielding of the foam casing.

It is respectfully submitted that the patent to Bohn et al. does not disclose tilting bolts. There is no structure in the patent to Bohn et al. that would inherently tilt the bolts when the Bohn et al structure is used for its intended purpose to actuate a horn.

The patent to Bohn et al. discloses that mounting tab 17 with dished recess 19 has a through hole 20 whose diameter is larger than the outer diameter of the mounting stud 10. This clearance is to aid in placement of the module into the foam. (Bohn et al. col. 3 lines 12-15). The patent to Bohn et al. also discloses that the mounting plate 30, (part of mounting tab 17) is the same in Figs. 1 and 2 and that the horn contacts located on the mounting tab 17 may be depressed

parallel to the steering wheel axis or may be tilted to actuate the horn switch. (Bohn et al, col. 3 lines 42-46).

The clearance space created by through hole 20 between mounting tab 17 and the mounting stud precludes any transfer of movement from the mounting tab to the stud 10. Thus, the stud 10 of Bohn et al. is not tilted during actuation of the horn switch.

Even if a large force is applied to the cover cap of Bohn et al., the bolts 10 will not inherently tilt. The cover cap wall 25 at the upper portion of bolt 10 will yield before the bolts will tilt. The cap will yield before the bolts will tilt because the bolts are stabilized against tilting by virtue of a relatively large surface area contact between the flange 11 on bolt 10 and the adjacent foam plateau compared with the small surface area contact between the thin walled section 25 of cover cap and the top section of the bolt 10.

Thus, claim 1 should be allowed.

Claims 2-11 depend from claim 1 and define over the patent to Bohn et al. for the same reasons as claim 1 and for the specific limitations recited therein. Claims 2-11 constitute merely further limitations to allowable claim 1. Thus, claims 2-11 should be allowed.

Claim 12 defines over the patent to Bohn et al. The patent to Bohn et al. does not disclose guides formed in one piece with the housing so that no clearance exists between the outer diameter of the guide and the housing, and an electrical contact on a housing which is displaceable with the covering

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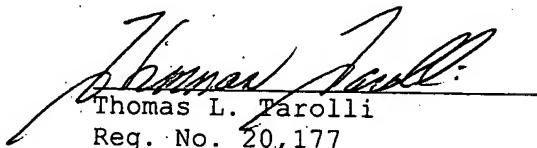
cap in an axial direction into contact with a corresponding electrical contact located on the steering wheel.

The patent to Bohn et al., discloses that mounting tab 17 with dished recess 19 has a through hole 20 whose diameter is larger than the outer diameter of the mounting stud 10. Thus, Bohn et al. discloses there is a clearance between the outer diameter of the stud and the mounting tab 17. Thus, claim 13 should be allowed.

In view of the foregoing, it is respectfully submitted that the above-identified application is in condition for allowance, and allowance of the above-identified application is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this amendment to our Deposit Account No. 20-0090.

Respectfully submitted,



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